

## **REMARKS**

Claims 1-5, 7-12, 14-19, 21-28 and 30-31 are pending in the application and all stand rejected.

This is an earnest attempt to show that all pending claim are in proper for immediate allowance. Reconsideration and allowance of all pending claims is respectfully requested in view of the following:

### ***Responses to Rejections to Claims – 35 U.S.C. §103***

Claims 1-5, 7-12, 14-19, 21-28 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al (U.S. Patent No. 5,027,343) (Chan hereinafter) in view of Raj et al (U.S. Patent No. 6,373,822) (Raj hereinafter) and the applicants admitted prior art (AAPA hereinafter). This rejection is not applicable to the pending claims.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, do not teach all of the elements of the pending claims.

For example, the pending claims substantially recite, in part, a local burn rack located at the local site for receiving the first SUT [system under test] and a remote burn rack located at the remote site for receiving the second SUT such that the first and second SUTs are tested and software is configured while operating together on the VLAN, as is defined throughout the specification and figures of the pending application.

As conceded by the Examiner on pages 3 and 4 of the Office Action mailed June 26, 2008, **"Chan does not specifically disclose such that the first and second SUT's are dynamically connected to and disconnected from a VLAN and a local burn rack located at the local site receiving the first SUT and a remote burn rack located at the remote site for receiving the second SUT."** The Examiner further conceded on page 4 of the Office Action mailed June 26, 2008 that, **"[t]he combined teachings of Chan and Raj do not specifically disclose a local burn rack located at the local site for receiving the first SUT and a remote burn rack located at the remote site for receiving the second SUT."** These concessions are agreed to.

However, the Office Action goes on to state, **"[t]he AAPA [applicant's admitted prior art] discloses a local burn rack located at the local site (see Chan for local site) for receiving the first SUT and a remote burn rack located at the remote site (see Chan for remote site) for receiving the second SUT (page 2, lines 7-13, which discusses a burn rack for testing, where the SUT is disposed within)."** Emphasis original. This statement is respectfully traversed, at least, because the rejection contradicts itself.

For example, as provided above, the rejection states that **"Chan does not specifically disclose . . . a local burn rack located at the local site . . . and a remote burn rack located at the remote site."** Then, to the contrary, the rejection states **"see Chan for local site"**, and **"see Chan for remote site"**. In support of this, the Office Action mailed January 29, 2008 stated on pages 2 and 3 that **"Chan does not specifically disclose a local burn rack located at the local site for receiving the first SUT and a remote burn rack located at the remote site for receiving the second SUT such that the first and second SUT's are configured and tested while operating together on the VLAN."** Thus, it is clear that different portions of the rejection are contradictory. As such, the rejection is defective and should be withdrawn.

It is submitted that the deficiencies of Chan and Raj, in this sense, are not remedied by AAPA. Page 2, lines 7-13 of the pending application, the portion of the application cited in the rejection, is provided below.

In a computer manufacturing environment, once a computer system is physically assembled, it is placed in a bay, or "cell," in a burn rack for testing and software configuration. Each burn rack bay includes various connectors, including a network connection for connecting a computer system, or "system under test" ("SUT"), disposed in the bay to a main manufacturing network of the manufacturer. The network connection to the main manufacturing network enables software to be downloaded to and various diagnostics to be performed on the SUT while it is disposed within the burn rack.

From this, it is clear that any AAPA that may be provided here does not disclose the deficient elements of Chan and Raj. For example, there is no mention of a local burn rack located at the local site for receiving the first SUT and a remote burn rack located at the remote site for receiving the second SUT such that the first and second SUTs are tested and software is configured while operating together on the VLAN.

In light of all the above, it is shown that any combination of the cited references fails to disclose, teach or suggest all of the elements of the pending claims. Thus, the rejection could not have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. In other words, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable. Therefore, the rejections should be withdrawn.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

In combining multiple references for a 103 rejection, the Supreme Court has ruled that the "teaching, suggestion, or motivation (TSM) test" still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739. The Court stated that "a patent composed of several elements is **not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.** Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify **a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.** This is so because inventions in most, if not all, instances rely upon building blocks long since

uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 1741, emphasis added.

In the present case, the Examiner has not expressed any reason why a person of ordinary skill in art would combine the references in the way the claimed new invention does.

Thus, in the present case it is clear that the USPTO's combination arises solely from hindsight based on the present disclosure without any reason why a person of ordinary skill in the art would combine the references as required by the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

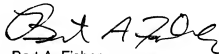
Therefore, independent claims 1, 8, 15, 21-23 and 30-31 and their respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of all pending claims is respectfully requested.

The Office Action contains characterizations of the claims and the related art to which the Applicant does not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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